

DOCKET NO: 283042US40PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
YASUSHI INAGAKI, ET AL. : EXAMINER: KALAM, ABUL
SERIAL NO: 10/565,078 :
FILED: JANUARY 18, 2006 : GROUP ART UNIT: 2814
FOR: MULTILAYER PRINTED WIRING BOARD :

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Election of Species Requirement stated in the Official Action dated October 9, 2008, Applicants provisionally elect species I, drawn to “a multilayer wiring board wherein at least one of the sum of the thicknesses of the power source conductive layers in said multilayer core substrate and the sum of the thicknesses of the ground conductive layers is larger than thickness of the conductive layer on the interlayer insulation layer” and identify Claims 1-8 as readable on the elected species.

Applicants respectfully traverse the outstanding election requirement for following reasons.

First, the outstanding Office Action simply states that “the species listed above do not relate to a single general inventive concept under PCT Rule 13.1, because, under PCT Rule 13.2, species lack the same or corresponding special technical features for the following reasons: Species II lacks the special technical feature of Species I, such as “wherein at least one of the sum of the thicknesses of the power source conductive layers in said multilayer core substrate and the sum of the thicknesses of the ground conductive layers is larger than

thickness of the conductive layer on the interlayer insulation layer.” It is respectfully submitted that without further information, the aforementioned findings are believed to lack grounds upon which it can be evaluated whether in fact the required distinctness and reasons for insisting on election are established. Accordingly, it is respectfully submitted that the PTO has not carried its burden of proof to establish distinctness.

Furthermore, MPEP §803 states the following:

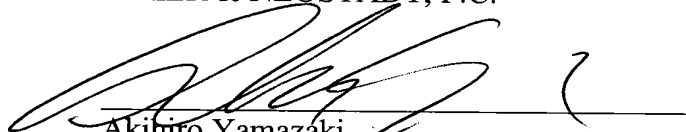
If the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

In the present application, all the claims are directed to multilayer printed wiring boards. Hence, it appears that all the claims in the present application are part of an overlapping search area and that a search for Claims 1-8 would necessarily include a search directed to Claim 9-29 as well. It is therefore believed that there is no undue burden on the Examiner to search all claims under MPEP §803, and Applicants respectfully traverse the Election of Species Requirement on the grounds that a search and examination of all the claims in the present application would not place a *serious* burden on the Examiner.

Accordingly, it is respectfully requested that the requirement to elect a single disclosed species be withdrawn, and that a full examination on the merits of each of Claims 1-29 be conducted.

Respectfully submitted,

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